

REMARKS

Claims 1-19 and 21-29 are pending. In response to the restriction requirement, Group II consisting of claims 1-19, 21-23, and 26-29 is elected with traverse and claims 24-25 are cancelled without prejudice.

Applicants traverse on the grounds that the Examiner has mischaracterized the current claimed invention, the applicable rules and regulations and misinterpreted the cited prior art. The Examiner cites 37 CFR 1.499 as support for requiring the Applicant to elect a single invention. 37 CFR §1.499 states that only if the Examiner finds that the national stage application “lacks unity of invention under [37 CFR] §1.475” may the Examiner require such an election. (37 CFR §1.475) Further, 37 CFR §1.475 states that “[a]n international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept” (37 CFR 1.475(a)). In the instant case, the Examiner states that the current claims do not relate to a single inventive concept because “they lack the same or corresponding special technical features” (Restriction Requirement, p. 2). However, instead of presenting any reasoning as to why the claims *of the instant application* fail to share the same corresponding technical features, the Examiner presents U.S. Patent 5,817,290 (‘290) to Jan Vijg et al. as anticipating claim 1 “and lacks special technical feature that binds all the groups together”. (Restriction Requirement, p. 2) The Examiner then states “[t]hus, Groups I-II are not so linked by the same or corresponding technical feature so as to form a single general inventive concept”. (Restriction Requirement, p. 2) However, instead of looking at the claims *as submitted* and providing a rationale as to why the claim groups lack the same or corresponding technical feature, the Examiner cites a prior art reference. The Applicant respectfully points out that the Examiner has not stated that the technical features of the instant Application do not make

a contribution over the prior art and yet the Examiner is attempting to utilize a prior art reference in determining whether technical features are lacking among claim groups. That being said, the Applicant submits that even if the Examiner had stated that the technical features of the instant Application do not make a contribution over the prior art, the Examiner has not provided any reasoning or rationale as to how the technical features of the claims lack novelty or inventive step in view of the reference(s). (MPEP 1850, IX. Examiner Note 18.07.02) Instead of providing any support or rationale, the Examiner simply cites Col. 8, lines 16-24 of the '290 reference as anticipating Group I, which state:

“Plasmids containing the *lacZ* reporter gene are excised from the genomic DNA by incubating the genomic DNA sample simultaneously with Hind III restriction enzyme and *lacI* repressor proteins coupled to magnetic beads. In the current protocol this separation step is almost 100% efficient and highly reproducible. After circularization by ligation, still in the presence of the magnetic beads, the plasmids are separated from the beads, ethanol precipitated and electrotransferred into *E. coli* C *lacZ*", *galE*-host cells. The bacteria are host-restriction negative in order to prevent degradation of incoming (methylated) plasmid DNA (Gossen and Vijg (1988) *Nucl. Acids Res.* 16:9343).”

(U.S. Patent 5,817,290, Col. 8, lines 16-24)

The '290 Patent discloses a test kit for mutagenesis testing which utilizes plasmids comprising *lacZ* reporter gene excised from genomic DNA utilizing Hind III, and *lacI* repressor proteins, which are then electrotransferred into *E. Coli*. However, the '290 Patent fails to disclose a method of separating and/or enriching prokaryotic DNA utilizing a protein which specifically binds prokaryotic DNA and has 25% to 35% homology with the wild type CPGB protein, as claimed. In fact, the '290 Patent fails to disclose CPGB at all. Thus, the '290 reference fails to anticipate Group I because it fails to disclose all elements claimed. As such, the '290 reference

cannot anticipate Group I and thus the Examiner has failed to show why the claims listed under Group I and II do not relate to a single inventive concept in accordance with PCT Rule 13.1.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Douglas J. Christensen', written in a cursive style.

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